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REAL PARTY IN INTEREST

The real party in interest is Jeffrey Lynn Chamberlain.

RELATED APPEALS AND INTERFERENCES

Appeal No. 2005-1271 of the Final Rejection of Application Serial Number 09/922,376 is related to this pending appeal because it concerned a commonly owned application having common subject matter and claimed the same priority application.

STATUS OF CLAIMS

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION

Claims in the application are: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: claim 6
2. Claims withdrawn from consideration but not canceled: 7, 8, 9, 10, 11, 12, 13, 14
3. Claims pending: 1, 2, 3, 4, 5, 15, 16, 17, 18, 19, 20
4. Claims allowed: None
5. Claims rejected: 1, 2, 3, 4, 5, 15, 16, 17, 18, 19, 20

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 2, 3, 4, 5, 15, 16, 17, 18, 19, 20

STATUS OF AMENDMENTS

No amendments have been filed after the 09/15/2011 Final Rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1-5 comprise: An edible reservoir (page 5, lines 7-10 of Substitute Specification) with a wall (item 10, Figures 5, 6, 9) having an edible fill aperture (page 5, lines 7-10 of Substitute Specification), edible valves (page 5, lines 7-10 of Substitute Specification), an edible cap (page 5, lines 7-10 of Substitute Specification), the edible valves having pressure actuated opening means (item 5, Figures 8, 9). Claim 2 adds an edible outer layer (page 5, lines 7-10 of Substitute Specification). Claim 3 adds indicia (item 9, Figure 3) to the edible outer layer of claim 2. Claim 4 adds a cord (item 7, Figure 2) to claim 1. Claim 5 adds a noisemaker (item 8, Figure 5) to claim 1.

Claims 15-20 comprise: A biodegradable reservoir (page 5, lines 7-10 of Substitute Specification) with a wall (item 10, Figures 5, 6, 9) which can hold liquid (Abstract) and is compressible (Figures 8, 9), a fill aperture (page 5, lines 7-10 of Substitute Specification), an airtight openable cap (item 4, Figure 6) which is biodegradable (page 5, lines 7-10 of Substitute Specification) through which liquid can be introduced to the reservoir through the fill aperture (Abstract), and valves which are pressure deformable slits (item 5, Figures 8, 9). Claim 16 adds an edible outer layer (page 5, lines 7-10 of Substitute Specification) with an aesthetic design (Abstract, Figure 3) to the wall of claim 15. Figure 17 adds indicia (item 9, Figure 3) to claim 16. Claim 18 adds a cord (item 7, Figure 2) to claim 15. Claim 19 adds edibility (page 5, lines 7-10 of Substitute Specification) to the biodegradable reservoir of claim 15. Claim 20 adds a noisemaker (item 8, Figure 5) to claim 15.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

35 U.S.C. §103(a) rejection of Claim 1

35 U.S.C. §103(a) rejection of Claims 2-3

35 U.S.C. §103(a) rejection of Claim 15

35 U.S.C. §103(a) rejection of Claims 16-17

35 U.S.C. §103(a) rejection of Claim 19

35 U.S.C. §103(a) rejection of Claim 4

35 U.S.C. §103(a) rejection of Claim 18

35 U.S.C. §103(a) rejection of Claim 5

35 U.S.C. §103(a) rejection of Claim 20

ARGUMENT

35 U.S.C. §103(a) rejection of Claim 1

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 1 that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 1 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 by Chamberlain's claim 16 has such limitations.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 1, is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46).

Peterson is clearly not disclosing a shell that is edible and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious. The teaching in Peterson cited by the Examiner does not apply to claim 1 because it concerns a specific structural limitation (the wrapper) not present in claim 1 (since it was added to claim 1 by the dependent claim 2).

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose an edible reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every edible element of Chamberlain's claim 1 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of edibility limitations in the elements of claim 1.

Concerning the Examiner's contention that the edible cap disclosed by this claim has been taught by Derrieu (EP0780316A1), Applicant respectfully disagrees. Derrieu discloses a biodegradable cap made of macromolecular thermoplastics. Whether such plastics may be biodegradable or not, they are not among the classes of materials anyone would regard as being edible to a dog. The fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish prima facie obviousness. In Re Baird, 16 F.2d 380, 382, 29 U.S.P.Q. 2D 1550, 1552 (Fed. Cir. 1994)). Applicant

clearly argued at page 8, last line through page 9, line 13 of his August 22, 2011 Response to Office Action that edibility and biodegradability are not the same thing and that such reasoning constituted impermissible hindsight on the part of the Examiner. Without addressing those arguments, examiner afterward has cited Derrieu's biodegradable cap as a prior art reference as against Chamberlain's edible cap. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Applicant further disagrees that Derrieu is in the same field of art as his dog watering toy or the same field of art as the primary reference cited by the Examiner. Derrieu is in the field of plastic product containers with a conservation/sterility cap. The Chamberlain invention is a dog toy. The Peterson invention is a tooth cleaning device for dogs and other pets. Claim 1 is not obvious.

35 U.S.C. §103(a) rejection of Claims 2-3

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 1 that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 1 (parent claim of claims 2-3) can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of

manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 (and contained in claim 3 which is dependent on claim 2) has such limitations.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 1(and therefore claims 2-3), is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is edible and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious.

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and

oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose an edible reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every edible element of Chamberlain's claim 1 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of edibility limitations in the elements of claims 2-3.

Concerning the Examiner's contention that the edible cap disclosed by these claims has been taught by Derrieu (EP0780316A1), Applicant respectfully disagrees. Derrieu discloses a biodegradable cap made of macromolecular thermoplastics. Whether such plastics may be biodegradable or not, they are not among the classes of materials anyone would regard as being edible to a dog. The fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish prima facie obviousness. In Re Baird, 16 F.2d 380, 382, 29 U.S.P.Q. 2D 1550, 1552 (Fed. Cir. 1994)). Applicant clearly argued at page 8, last line through page 9, line 13 of his August 22, 2011 Response to Office Action that edibility and biodegradability are not the same thing and that such reasoning constituted impermissible hindsight on the part of the Examiner. Without addressing those arguments, examiner afterward has cited Derrieu's biodegradable cap as a prior art reference as against Chamberlain's edible cap. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed

subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Applicant further disagrees that Derrieu is in the same field of art as his dog watering toy or the same field of art as the primary reference cited by the Examiner. Derrieu is in the field of plastic product containers with a conservation/sterility cap. The Chamberlain invention is a dog toy. The Peterson invention is a tooth cleaning device for dogs and other pets.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 1 is nonobvious, therefore claims 2-5 are also nonobvious. Claims 2 and 3 are not obvious.

35 U.S.C. §103(a) rejection of Claim 15

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 15 that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 15 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the

functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 by Chamberlain's claim 16 has such limitations.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 15, is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is biodegradable and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious. The teaching in Peterson cited by the Examiner does not apply to claim 15 because

it concerns a specific structural limitation (the wrapper) not present in claim 15 (since it was added to claim 15 by the dependent claim 16).

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose a biodegradable reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every biodegradable element of Chamberlain's claim 15 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of biodegradability limitations in the elements of claim 15. Claim 15 is not obvious.

35 U.S.C. §103(a) rejection of Claims 16-17

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claims 16-17 that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 15 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using

applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 by Chamberlain's claim 16 and 17 has such limitations.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 15 (and therefore of claims 16-17), is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is biodegradable and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that

materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious.

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose a biodegradable reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every biodegradable element of Chamberlain's claim 15 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of biodegradability limitations in the elements of claims 16-17.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 15 is nonobvious, therefore claims 16-20 are also nonobvious. Claims 16 and 17 are not obvious.

35 U.S.C. §103(a) rejection of Claim 19

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 19 that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 19 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire

Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 (the parent claim to claim 19) by Chamberlain's claim 16 has such limitations. Claim 19 does not contain the outer layer limitation added to claim 15 by claim 16.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 19, is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an

explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is edible and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious.

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson states can be used to construct the wrapping. Peterson does not disclose an edible biodegradable reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every biodegradable element of Chamberlain's claim 19 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson teaches away from edibility of her shell and Chamberlain claim 19 is therefore patentably distinct from Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Peterson cannot have been teaching that rawhide is the functional equivalent of another material in construction of a cap, since she doesn't even disclose a cap.

Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of biodegradability limitations in the elements of claim 15 and the further limitation of edibility of the reservoir as taught by claim 19.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 15 is nonobvious, therefore claim 19 is also nonobvious.

35 U.S.C. §103(a) rejection of Claim 4

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 1 (parent claim to claim 4) that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 1 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 by Chamberlain's claim 16 has such limitations.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 1, is expressly stated by Peterson to require

"sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is edible and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious. The teaching in Peterson cited by the Examiner does not apply to claim 4 because it concerns a specific structural limitation (the wrapper) not present in claim 4 (since it was added to claim 1 by the dependent claim 2 while claim 4 depends directly from claim 1).

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose an edible reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every edible element of Chamberlain's claim 1 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of edibility limitations in the elements of claim 4.

Deshaies (US Patent 5,944,516) specifically teaches away from the combination of references being

used by the Examiner (See column 2, lines 3-7 where Deshaies states that dogs could tear apart large pieces of rope and choke on them). Applicant respectfully contends that Examiner is incorrect in her application of Deshaies to her obviousness analysis of claim 4.

Concerning the Examiner's contention that the edible cap disclosed by this claim has been taught by Derrieu (EP0780316A1), Applicant respectfully disagrees. Derrieu discloses a biodegradable cap made of macromolecular thermoplastics. Whether such plastics may be biodegradable or not, they are not among the classes of materials anyone would regard as being edible to a dog. The fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish prima facie obviousness. In Re Baird, 16 F.2d 380, 382, 29 U.S.P.Q. 2D 1550, 1552 (Fed. Cir. 1994)). Applicant clearly argued at page 8, last line through page 9, line 13 of his August 22, 2011 Response to Office Action that edibility and biodegradability are not the same thing and that such reasoning constituted impermissible hindsight on the part of the Examiner. Without addressing those arguments, examiner afterward has cited Derrieu's biodegradable cap as a prior art reference as against Chamberlain's edible cap. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Applicant further disagrees that Derrieu is in the same field of art as his dog watering toy or the same field of art as the primary reference cited by the

Examiner. Derrieu is in the field of plastic product containers with a conservation/sterility cap. The Chamberlain invention is a dog toy. The Peterson invention is a tooth cleaning device for dogs and other pets.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 1 is nonobvious, therefore claims 2-5 are also nonobvious. Claim 4 is not obvious.

35 U.S.C. §103(a) rejection of Claim 18

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 15 (parent claim of claim 18) that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 15 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 15 by Chamberlain's claim 16 has such limitations. (Claim 18 depends directly from claim 15 and therefore has no such limitation.)

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure

1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 15, is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is edible and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious. The teaching in Peterson cited by the Examiner does not apply to claim 18 because it concerns a specific structural limitation (the wrapper) not present in claim 18 (since it is not in claim 15 the parent claim from which claim 18 depends and it is not added by claim 18).

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell

(12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose an edible reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every edible element of Chamberlain's claim 18 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of edibility limitations in the elements of claim 18.

Deshaies (US Patent 5,944,516) specifically teaches away from the combination of references being used by the Examiner (See column 2, lines 3-7 where Deshaies states that dogs could tear apart large pieces of rope and choke on them). Applicant respectfully contends that Examiner is incorrect in her application of Deshaies to her obviousness analysis of claim 4.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 15 is nonobvious, therefore claim 18 is also nonobvious.

35 U.S.C. §103(a) rejection of Claim 5

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 1 (parent claim of claim 5) that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 1 can be edible because Peterson discloses they can all be rawhide and further that

Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 by Chamberlain's claim 16 has such limitations. Claim 5 depends directly from claim 1 and therefore does not contain the wrapper/outer layer.

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 1, is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is edible and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious. The teaching in Peterson cited by the Examiner does not apply to claim 5 because it concerns a specific structural limitation (the wrapper) not present in

claim 5 (since it was added to claim 1 by the dependent claim 2 but not added to claim 5, which depends directly from claim 1).

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose an edible reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every edible element of Chamberlain's claim 5 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of edibility limitations in the elements of claim 5.

Concerning the Examiner's contention that the edible cap disclosed by this claim has been taught by Derrieu (EP0780316A1), Applicant respectfully disagrees. Derrieu discloses a biodegradable cap made of macromolecular thermoplastics. Whether such plastics may be biodegradable or not, they are not among the classes of materials anyone would regard as being edible to a dog. The fact that a claimed subgenus is encompassed by a prior art genus is not sufficient by itself to establish prima facie obviousness. In Re Baird, 16 F.2d 380, 382, 29 U.S.P.Q. 2D 1550, 1552 (Fed. Cir. 1994)). Applicant clearly argued at page 8, last line through page 9, line 13 of his August 22, 2011 Response to Office Action that edibility and biodegradability are not the same thing and that such reasoning constituted impermissible hindsight on the part of the Examiner. Without addressing those arguments, examiner afterward has cited Derrieu's biodegradable cap as a prior art reference as against Chamberlain's edible

cap. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Applicant further disagrees that Derrieu is in the same field of art as his dog watering toy or the same field of art as the primary reference cited by the Examiner. Derrieu is in the field of plastic product containers with a conservation/sterility cap. The Chamberlain invention is a dog toy. The Peterson invention is a tooth cleaning device for dogs and other pets.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 1 is nonobvious, therefore claims 2-5 are also nonobvious. Claim 5 is not obvious.

35 U.S.C. §103(a) rejection of Claim 20

The appropriate inquiry is whether the invention taken as a whole would have been obvious to one of ordinary skill in the relevant art at the time the invention was made. (Graham v. John Deere, 383 U.S. 1 (1966)). Examiner argues in paragraph 7 of her 09/15/2011 Final Rejection of claim 15 (parent claim to claim 20) that Peterson (US Patent 5,857,431) discloses at Column 2, lines 5-8 that all components of Chamberlain's claim 15 can be edible because Peterson discloses they can all be rawhide and further that Peterson discloses that rawhide is a functional equivalent of latex for purposes of manufacturing

the entire Chamberlain apparatus. Equivalence must be recognized in the prior art and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents. (In Re Ruff, 256 F.2d 590, 118 U.S.P.Q. 340 (C.C.P.A. 1958)). Here Examiner is claiming equivalence based on an ambiguous statement by Peterson concerning the wrong structure and is using applicant's disclosure to make the needed connection. Peterson actually discloses in that passage only that a wrapper (the functional equivalent of the edible outer layer added to Chamberlain's claim 1 by Chamberlain's claim 2 and added to Chamberlain's claim 15 by Chamberlain's claim 16 has such limitations. Claim 20 has no such limitation because it depends directly from claim 15. (There is no wrapper in claim 20).

In Peterson, the wrapper (item 412 of Figure 6) is not the same thing as the shell seen at (12) of Figure 1. That is shown by column 4, lines 47-50 discussing Figure 6 where the shell is expressly stated to be not shown by that figure that shows the wrapper (412). Peterson's shell (12) containing the openings that Examiner equates to the valves of Chamberlain's claim 15, is expressly stated by Peterson to require "sufficient elasticity to retain its shape, that does not disintegrate upon biting thereinto." (Column 3, lines 6-9). Since the shell does not disintegrate when a dog bites it and it retains its shape, it is not made of rawhide despite Examiner's contentions to the contrary. Examiner should make explicit findings about the similarities and differences between the prior art genus and the claimed subgenus because the question is whether the invention taken as a whole would have been obvious. (Stratoflex v. Aeroquip Corp., 713 F. 2d 1530, 1537, 218 U.S.P.Q. 871, 877 (Fed. Cir. 1983)). Examiner's fact findings should specifically point out what teachings or suggestions in the prior art would have motivated a person of ordinary skill in the art to select the claimed subgenus. (In Re Kulling, 897 F. 2d 1147, 1149, 14 U.S.P.Q. 2D 1056, 1057 (Fed. Cir. 1990)). Instead of doing that, Examiner has treated edibility and biodegradability as though they are the same without making an

explicit comment and proceeds to lump all the elements of Applicant's invention as functional equivalents of the Peterson wrapper. Peterson states that integrity of the shell is paramount during the impregnation of the shell by any oderant. (Column 3, lines 44-46). Peterson is clearly not disclosing a shell that is biodegradable and is in fact teaching away from such a shell. Even the Examiner can see that it is the "shell" of Peterson that is analogous to Chamberlain's reservoir, but she argues that materials Peterson uses to construct the wrapper are what makes every element of the Chamberlain invention obvious. The teaching in Peterson cited by the Examiner does not apply to claim 20 because it concerns a specific structural limitation (the wrapper) not present in claim 20.

The passage from Peterson at Column 3, line 12 is discussing the material which can form the shell (12) while the passage at column 2, line 5 concerns the wrapping. The Examiner is mixing apples and oranges in arguing that materials Peterson claims can be used to construct the shell are the functional equivalents of materials Peterson can be used to construct the wrapping. Peterson does not disclose an biodegradable reservoir in her disclosure of her shell. Her discussion of an edible wrapping does not constitute a blanket teaching that every biodegradable element of Chamberlain's claim 15 (reservoir with a wall, fill aperture, valves; and cap) are taught by Peterson. Peterson doesn't even have a cap, as Examiner admits in the sixth and seventh lines of her paragraph 6 of the September 15, 2011 final rejection. Applicant respectfully contends that Examiner is incorrect in her application of Peterson to the teaching of edibility limitations in the elements of claim 20.

If an independent claim is nonobvious then all the claims depending from that claim are nonobvious. (In Re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2D 1596 (Fed. Cir. 1988)). Claim 15 is nonobvious, therefore claim 20 is also nonobvious.

WHEREFORE, Applicant Jeffrey Lynn Chamberlain respectfully prays that the board overrule the Examiner's final rejection of claims 1-5 and 15-20 and direct the Examiner to declare this application allowable.

Respectfully Submitted, Dated: Feb. 15, 2012

Charles R. Sutton, Reg. No. 42,176

CLAIMS APPENDIX

1. (Previously presented) An apparatus to alleviate pet thirst comprising:

an edible reservoir having a wall, said wall having an edible fill aperture and edible valves; said edible fill aperture having an edible cap, said edible cap when open allowing liquid to enter said edible reservoir through said edible fill aperture, said edible cap when closed denying egress from said edible reservoir; said edible valves having pressure actuated opening means, said edible valves under pressure allowing liquid to exit said edible reservoir, said edible valves when not under pressure denying egress from said edible reservoir.

2. (Previously presented) The apparatus of claim 1 further comprising an edible outer layer enclosing said wall, said edible outer layer having an aesthetic design.

3. (Previously presented) The apparatus of claim 2 further comprising indicia on said edible outer layer.

4. (Original) The apparatus of claim 1 further comprising a cord attached to said apparatus.

5. (Previously presented) The apparatus of claim 1 further comprising a noisemaker contained within said edible reservoir.

6. (Canceled)

7. (Withdrawn) In combination:

a reservoir having a wall, said wall having a fill aperture and valves, said fill aperture having an openable cap, said valves comprising bores penetrating said wall;

a valve mechanism shaped substantially to fill said bores, said valve mechanism being capable of alternate movement substantially perpendicular to said wall, said valve mechanism having an opening permitting liquid to flow from said reservoir during a first state of the alternate movement of said valve mechanism, said opening being blocked by said wall during a second state of the alternate movement

of said valve mechanism;

return means urging said valve mechanism to said second state of the alternate movement of said valve mechanism;

said valve mechanism being movable to said first state of the alternate movement of said valve mechanism by application of pressure.

8. (Withdrawn) The apparatus of claim 7 further comprising said pressure is applied to said valve mechanism.

9. (Withdrawn) The apparatus of claim 7 further comprising said pressure is applied to said wall.

10. (Withdrawn) The apparatus of claim 7 further comprising a cord having attachment means, said attachment means connecting said cord to said apparatus.

11. (Withdrawn) the apparatus of claim 7 further comprising an outer layer attached to said wall, said outer layer having an aesthetic design.

12. (Withdrawn) The apparatus of claim 11 wherein said outer layer bears indicia.

13. (Withdrawn) The apparatus of claim 7 further comprising a noisemaker contained within said reservoir.

14. (Withdrawn) The apparatus of claim 7 further comprising a nipple like structure, said nipple like structure extending from said wall, said valves being located on said nipple like structure.

15. (Currently amended) A pet care apparatus comprising a biodegradable reservoir having a wall, a fill aperture, and valves; said wall being adapted to hold liquid and being compressible; said fill aperture having an airtight openable biodegradable cap; said biodegradable cap when open permitting liquid to be introduced to said biodegradable reservoir through said fill aperture; said valves being slits deformable by pressure; whereby creating a net greater pressure inside said biodegradable reservoir

when said biodegradable reservoir contains liquid and when said biodegradable cap is airtight will cause said liquid to exit said valves.

16. (Previously presented) The pet care apparatus of claim 15 further comprising an edible outer layer attached to said wall, said edible outer layer having an aesthetic design.

17. (Previously presented) The pet care apparatus of claim 16 wherein said edible outer layer bears indicia.

18. (Previously presented) The pet care apparatus of claim 15 further comprising a cord attached to said pet care apparatus.

19. (Previously presented) The pet care apparatus of claim 15 wherein said biodegradable reservoir is edible.

20. (Previously presented) The pet care apparatus of claim 15 further comprising a noisemaker inside said biodegradable reservoir and said biodegradable reservoir has biodegradable valves.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

Appeal No. 2005-1271 of the Final Rejection of Application Serial Number 09/922,376 is related to this pending appeal because it concerned a commonly owned application having common subject matter and claimed the same priority application. A copy of the 05/25/2005 Decision on Appeal by the Board of Patent Appeals and Interferences follows.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY LYNN CHAMBERLAIN

Appeal No. 2005-1271
Application No. 09/922,376

ON BRIEF

Before KIMLIN, GARRIS and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-5, 7, 8 and 10-13. Claims 6, 9 and 14-20 stand withdrawn from consideration. Claim 2 is illustrative:

2. An apparatus to alleviate pet thirst comprising:

a reservoir having a wall, said wall having a fill aperture and valves; said fill aperture having a closeable openable cap, said cap when open allowing liquid to enter said reservoir through said fill aperture, said cap when closed denying egress from said reservoir; said valves having pressure actuated opening

means, said valves under pressure allowing liquid to exit said reservoir, said valves when not under pressure denying egress from said reservoir; an outer layer enclosing said wall, said outer layer being shaped to resemble a food item.

Appellant further states that "[c]laim 1 is actually deleted and therefore simply needs to be cancelled" (page 10 of principal brief, second sentence).

The examiner relies upon the following references in the rejections of the appealed claims:

Deshaies	5,944,516	Aug. 31, 1999
Huettner et al. (Huettner)	6,092,489	Jul. 25, 2000
Hass	5,961,406	Oct. 5, 1999

Appellant's claimed invention is directed to an apparatus or device for alleviating the thirst of a pet, such as a dog. An outer wall defines a reservoir for a liquid, such as water, and the wall contains pressure actuated valves which allow the liquid to exit the reservoir when pressure is exerted by, for example, the bite of a dog. An outer layer encloses the wall and is shaped to resemble a food item, such as a bone.

Appealed claims 1, 2, 7, 8 and 11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Deshaies. Claims 3 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deshaies, while claims 4 and 10 stand rejected under § 103 as being unpatentable over Deshaies in view of Hass.

In addition, claims 5 and 13 stand rejected under § 103 as being unpatentable over Deshaies in view of Huettner.

In accordance with the grouping of claims set forth at page 9 of the principal brief, claims 3 and 12 stand or fall together, as do claims 4 and 10, and claims 5 and 13.

We have carefully considered each of the arguments advanced by appellant. However, we are in complete agreement with the examiner's reasoned and thorough analysis and application of the prior art, as well as her cogent disposition of the arguments raised by appellant. Accordingly, we will adopt the examiner's reasoning as our own in sustaining the rejections of record, and we add the following for emphasis only.

We consider first the examiner's rejection under § 102 over Deshaies. As explained by the examiner, Deshaies, like appellant, discloses an apparatus having a reservoir defined by a wall having a fill aperture and valves therein for allowing the ingress and egress of a liquid. The valves of Deshaies have pressure actuated opening means, as presently claimed, such that when pressure is exerted by the bite of a dog liquid exits the reservoir through the valves. Also, Deshaies expressly teaches that in order to attract an animal, such as a dog, the hollow portion of the device "can be shaped to look like a dog bone [or]

can take on any one of numerous shapes so as to attract the interest of a pet" (column 8, lines 46-49). Consequently, we agree with the examiner that Deshaies describes the subject matter of claims 1, 2, 7, 8 and 11 within the meaning of § 102.

Appellant contends that the device of Deshaies does not have an outer layer that is shaped to resemble a food item since "its surface is covered with brushes" (page 12 of principal brief, first paragraph). However, the fact that a brush can protrude from the outer layer does not negate the fact that the outer layer of Deshaies, itself, can be shaped to resemble a food item, such as a bone. Furthermore, Deshaies teaches that the brush protrudes from the outer layer only when it is compressed (see column 3, lines 3 et seq. and 22-25).

With respect to claims 7 and 8, appellant maintains that Deshaies does not disclose a valve mechanism capable of alternate movements substantially perpendicular to the wall. Appellant points out that "[t]he Deshaies invention shows valves at Figure 7 which are slits deformable under pressure and there fore [sic, therefore] move in a direction substantially parallel with the wall" (page 11 of principal brief, second paragraph). However, the examiner explains that Figures 2 and 7 of Deshaies were not relied upon in the rejection but, rather, the examiner cites

Figure 3 of the reference for disclosing a valve mechanism 46 that moves substantially perpendicular to the wall. We note that appellant's Reply Brief does not address the substance of Deshaies' Figure 3.

Turning to the § 103 rejection of claims 3 and 12, we fully concur with the examiner that it would have been obvious for one of ordinary skill in the art to apply indicia to the device of Deshaies for any of a number of reasons, including to make the device more attractive to the buying public.

Regarding the § 103 rejection of claims 4 and 10 over Deshaies in view of Hass, we are satisfied that it would have been obvious for one of ordinary skill in the art to attach a cord to the device of Deshaies "in order to enable the owner to carry the device without having to contact the chewed portion of the device" (page 5 of Final rejection, last paragraph). Although appellant points out that Deshaies teaches that rope bones may result in a dog choking on large pieces of rope, this is certainly not tantamount to a teaching away of attaching <u>any</u> rope of <u>any</u> material to the device. Furthermore, it is a matter of obviousness for one of ordinary skill in the art to employ a known feature along with its attendant disadvantages. As for appellant's argument that the combination of Deshaies with Hass

would be inoperative, the examiner properly sets forth that "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference" (page 6 of Answer, last paragraph). In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Concerning the § 103 rejection of claims 5 and 13 over Deshaies in view of Huettner, we are convinced that it would have been obvious for one of ordinary skill in the art to incorporate a noise maker into the device of Deshaies. Indeed, as acknowledged at page 1 of appellant's specification, it was known in the art to provide a noise maker, such as a bell, inside an edible toy for a dog.

As a final point, we note that appellant bases no argument upon objective evidence of nonobviousness, such as unexpected results.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
BEVERLY PAWLIKOWSKI)
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